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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,627	03/01/2002	Vincent Formale	RSW920020013 US1	3717

7590 07/28/2006

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EXAMINER

THEIN, MARIA TERESA T

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/087,627

Applicant(s)

FORMALE ET AL.

Examiner

Marissa Thein

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicants' "Response to Office Action Dated January 31, 2006" filed on May 5, 2006 has been considered.

Applicants' response by virtue of amendment to claims 11-18 has overcome the Examiner's objection.

Claims 10-18 are amended. Claims 1-18 remain pending in this application.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the book "Intermediate Accounting", (pages 499-521) (tenth edition) in view of U.S. Patent No. 6,047,267 to Owens et al.

Regarding claims 1 and 9, Intermediate Accounting discloses classifying an asset as capital or an expensed asset (page 518) comprising: assigning with respect to each of a plurality of machines an average value of models of the machine type (page 509); selecting a minimum capitalization value (page 518); receiving purchase data signifying the acquisition of an asset (page 501; page 502); determining a machine type of the acquired asset (page 50; page 502); correlating the machine type of the acquired

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asset to the average value assigned to the machine type in step ((page 509; page 514); and if the average value for the machine type of the acquired asset is greater than or equal to said minimum capitalization value, classifying the asset as a capital asset, and if the average value of r the machine type of the acquired asset is less than the minimum capitalization value, classifying the asset as an expensed asset (page 518).

However, Intermediate Accounting does not disclose a computer readable product embodied on computer readable media readable by a computing device.

Owens, on the other hand, teaches a computer readable product embodied on computer readable media readable by a computing device (col. 3, lines 14-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the Intermediate Accounting, to include a computer readable product embodied on computer readable media readable by a computing device, as taught by Owens, in order to automatically gather and store information.

Claims 2-8 and 10-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over the book "Intermediate Accounting", (pages 499-519) (tenth edition) in view of U.S. Patent No. 6,047,267 to Owens et al. as applied to claims 1 and 9 above, and further in view of U.S. Patent No. 2002/0082966 to O'Brien.

Intermediate Accounting substantially discloses the claimed invention, however, the combination does not disclose the models of the machine type; determining a value of the models; calculating the average value of the models; instructions for weighing the

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value of each model; weighting the value of each model as a function of predicted purchasing trends of models; the value of the models are derived form the manufacturer's suggested retail price of said model; the value of the models are derived form the manufacturer's base manufacturing cost; determining the values of a predetermined date; the date of commercial release; a data stem containing the purchaser orders; and reading the machine type out of a data field in the purchase order.

O'Brien, on the other hand, teaches the models of the machine type (paragraph 37; paragraphs 160-162; paragraphs 166-167); determining a value of the models (paragraph 37; paragraphs 160-162; paragraphs 166-167); calculating the average value of the models (paragraph 37; paragraphs 160-162; paragraphs 166-167); instructions for weighing the value of each model (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); weighting the value of each model as a function of predicted purchasing trends of models (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); the value of the models are derived form the manufacturer's suggested retail price of said model (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); the value of the models are derived form the manufacturer's base manufacturing cost (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); determining the values of a predetermined date (paragraph 16; paragraph 137; paragraphs 75-77; paragraphs 158-162; paragraphs 163-167); the date of commercial release (paragraph 16; paragraph 137; paragraphs 75-77;

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paragraphs 158-162; paragraphs 163-167); a data stem containing the purchaser orders (paragraph 37; paragraph 156; paragraph 158); and reading the machine type out of a data field in the purchase order (paragraph 37; paragraph 156; paragraph 158).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to modify the combination, to include the model and data stream containing the purchase order, in order to capture and retain information relating to cost and utilization of an asset in order to facilitate better procurement and other business decisions (O'Brien, paragraph 5).

Response to Arguments

Applicants' arguments filed May 5, 2006 have been fully considered but they are not persuasive.

Applicants remark "IA does not teaches anything pertaining to the function of the claimed invention, namely, determining whether to classify an asset as either a capital asset or an expensed assets".

The Examiner notes that IA (Intermediate Accounting) discloses "determining whether to classify an asset as either a capital asset or an expensed assets". IA discloses plant assets which incur costs, wherein the costs are allocated to the proper time periods. (page 518). IA further discloses the costs which is incurred to achieve greater further benefits should be capitalized, whereas expenditures that simply maintain a given level of services should be expensed (page 518). In capitalizing the costs, one of the conditions must be met: the useful life of the asset must be increased; the quantity of units produced from the asset must be increased; or the quality of the

units produced must be enhanced. Moreover, IA discloses expensed asset, which includes expenditures that do not increase an asset's future benefits. (Middle of page 518)

Such plant assets which incur costs, wherein the costs incurred is to achieve greater benefits are capitalized assets and expenditures that maintain a given level of services should be categorized as expensed asset are considered "determining whether to classify an asset as either a capital asset or an expensed assets".

Applicants remark that "there is no disclosure of any of (1) determining the average value of models of a machine type, (2) comparing that average value to a minimum capitalization value or (3) classifying the asset as a capital assets or an expensed asset based on that comparison.

The Examiner does not agree. IA discloses the valuation of an asset which is recorded at the fair market value of what is given up or the fair value of the asset received (Valuation, top of page 509). In estimating fair market value or fair value, estimate information is provided by the average pricing of the asset (machine). Furthermore, IA at pages 513-514 shows "fair value" of machines (see illustration 10-14 and 10-15). Such fair value or fair market value is known in accounting arts as an average value of an asset (machine). For example, the well-known Kelley Blue book provides values of automobiles specially described as "average fair market value". In determining and estimating the average fair market value, the prices of all the same model, make and year of the cars are compared. Furthermore, IA discloses the allocating of the costs and additional costs to an asset to the proper time periods. Costs

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incurred to achieve greater future benefits for the assets should be capitalized, where as expenditures that simple maintain a given level of services to the asst should be expensed. IA discloses the cost of the asset to be capitalized, conditions must be met: the useful life of the asst must be increased; the quantity of units produced from the asset must be increased, and the quality of the united produced by the asset must be enhance. Expenditures that do not increase an asset's future benefits should be expensed. IA also discloses expenditures below an established arbitrary minimum amount are expensed, rather than capitalized. Moreover, IA discloses the determining of the unit type (machine type) with which costs should be associated is critical. (Middle of page 518)

Such fair market value and fair value; distinction of determining a capital asset and to an expensed asset; expenditures below an established arbitrary minimum amount are expensed, rather than capitalized; and the determination of the unit type with which costs should be associated is critical are considered "the determining the average value of models of a machine type; comparing that average value to a minimum capitalization value; or classifying the asset as a capital assets or an expensed asset based on that comparison".

Applicants remark that "there is absolutely nothing suggesting averaging the prices of a plurality of assets, let alone averaging the cost of a plurality of assets of a given machine type".

Examiner draws Applicants' attention to the discussion above.

Applicants remark that "IA does not disclose at least (1) assigning with respect to each of the plurality of machine types and average value of models of said machine type, (4) determining a machine type of said acquired asset, (5) correlating said machine type of said acquired asset to sit average assigned to said machine type, (6) if said average value for said machine type of said acquired asset is greater than or equal to said minim capitalization value, classifying said asset as a capital asset and, if said average value for said machine type of said acquired asset is last man said minimum capitalization value, classifying said asset as an expensed asset."

The Examiner does not agree and repeats the discussion above. IA discloses the valuation of an asset which is recorded at the fair market value of what is given up or the fair value of the asset received (Valuation, top of page 509). In estimating fair market value or fair value, estimate information is provided by the average pricing of the asset (machine). Furthermore, IA at pages 513-514 shows "fair value" of machines (see illustration 10-14 and 10-15). Such fair value or fair market value is known in accounting arts as an average value of an asset (machine). For example, the well-known Kelley Blue book provides values of automobiles specially described as "average fair market value". In determining and estimating the average fair market value, the prices of all the same model, make and year of the cars are compared. Furthermore, IA discloses the allocating of the costs and additional costs to an asset to the proper time periods. Costs incurred to achieve greater future benefits for the assets should be capitalized, where as expenditures that simple maintain a given level of services to the asset should be expensed. IA discloses the cost of the asset to be capitalized,

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conditions must be met: the useful life of the asst must be increased; the quantity of units produced from the asset must be increased, and the quality of the united produced by the asset must be enhance. Expenditures that do not increase an asset's future benefits should be expensed. IA also discloses expenditures below an established arbitrary minimum amount are expensed, rather than capitalized. Moreover, IA discloses the determining of the unit type (machine type) with which costs should be associated is critical. (Middle of page 518)

Such valuation of an asset that is recorded at the fair market value or fair value; the conditions to be met to categorize an asset as either capital or expensed asset; expenditures below an established arbitrary minimum amount are expensed, rather than capitalized; and the determination of the unit type (machine type) with which costs should be associated is critical are considered "(1) assigning with respect to each of the plurality of machine types and average value of models of said machine type, (4) determining a machine type of said acquired asset, (5) correlating said machine type of said acquired asset to sit average assigned to said machine type, (6) if said average value for said machine type of said acquired asset is greater than or equal to said minimum capitalization value, classifying said asset as a capital asset and, if said average value for said machine type of said acquired asset is last man said minimum capitalization value, classifying said asset as an expensed asset".

Applicants remark that O'Brien does suggest "calculating he average value of models of a particular machine type and weighing the models of a certain machine type equally in order to determine the average as well as the alternate embodiment of

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weighing the based on predicted purchasing trends". Furthermore, Applicant further remarks that O'Brien does not the features of "(1) the manufacturer's suggest retail price of said model to calculate the average value, (2) the manufacturer's base manufacturing costs to calculate the aforementioned average value, and (3) some value as of the date of commercial release to calculate the average".

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Nonetheless, IA discloses the classifying of the asset as either capital or expensed asset. IA discloses the valuation of an asset which is recorded at the fair market value of what is given up or the fair value of the asset received (Valuation, top of page 509). In estimating fair market value or fair value, estimate information is provided by the average pricing of the asset (machine). Furthermore, IA at pages 513-514 shows "fair value" of machines (see illustration 10-14 and 10-15). Such fair value or fair market value is known in accounting arts as an average value of an asset (machine). For example, the well-known Kelley Blue book provides values of automobiles specially described as "average fair market value". In determining and estimating the average fair market value, the prices of all the same model, make and year of the cars are compared. IA further asserts that the determining of the unit type (machine type) with which costs should be associated is critical (middle of page 518). The Examiner then

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turns to O'Brien to further support the teaching of calculating the average value of models of a particular machine type. O'Brien teaches a system which can benchmark information relating to a particular asset against similar information for an entire group of similar assets (paragraph 15). The system provides the ability to define the group of assets included in a particular analysis (paragraph 15). O'Brien teaches a benchmark value as a numeral or financial value which can be averaged from each other (paragraph 162). Furthermore, O'Brien teaches how benchmarking is performed. The first step is the selection of asset to be included in the benchmarking information pool for the particular benchmark analysis (Figure 13; paragraph 165). Assets are selected on the basis of having a particular characteristic (for example, the characteristics of being a vehicle and having a maximum speed) or on the basis of having a particular value of the characteristic (for example, having a maximum speed of less than 40 miles per hour) (paragraph 165). The system provides the analyst with significant flexibility in selecting assets for inclusion into a particular benchmarking analysis (paragraph 165). Second is the process of selecting the characteristics related to the benchmark pool assets that are to be included in the pool of benchmark information. The analysts can select as many or as few characteristics. (Paragraph 166) Asset characteristics include data value which is the particular characteristics value of a particular asset such as the pricing of the particular asset (paragraph 156); and manufacturer information (paragraph 158). Third is the process of requiring the analyst to decide whether a comparison is desired. Assets that perform similar functions can be pooled together for benchmarking purposes, and various accounting and cost characteristics are

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benchmarked for the entire pool of assets. The resulting aggregate and average benchmark values can be compared to the characteristics of the asset that is being considered. (Paragraph 167) Using the system, it is possible for a seller or manufacture to provide some performance standards cost related warranties relating to the benchmarked accounting characteristic (paragraph 167). Benchmarking functionality is the ability to determine what the total cost of ownership for a particular asset is before the asset is purchased (paragraph 169). Benchmarking costs can be an important part of a company's budgetary process (paragraph 170) to facilitate increasingly informed purchasing decisions in the future (paragraph 2). The benchmarking functionality can be used to determine the cost of asset over various different time increments. This data can be compiled and make available to businesses so that more accurate budgets can be prepared. (Paragraph 170)

Such a system which can benchmark information relating to a particular asset against similar information for an entire group of similar assets by selecting the assets and the characteristic of the assets and the comparison of the assets; the assets being pooled together for benchmarking purposes with the combination of benchmarking by accounting and cost characteristics, wherein the resulting of aggregating and averaging the values can be used to compare to the characteristic of the asset being considered; benchmark value; benchmarking costs can be an important part of a company's budgetary process to facilitate increasingly informed purchasing decisions in the future are considered "calculating he average value of models of a particular machine type and weighing the models of a certain machine type equally in order to determine the

average as well as the alternate embodiment of weighing the based on predicted purchasing trends”.

Such a system which can benchmark information relating to a particular asset against similar information for an entire group of similar assets by selecting the assets and the characteristic of the assets and the comparison of the assets; the assets being pooled together for benchmarking purposes with the combination of benchmarking by accounting and cost characteristics, wherein the resulting of aggregating and averaging the values can be used to compare to the characteristic of the asset being considered; benchmark value; the asset characteristic can include data value which is the particular characteristics value of a particular asset and manufacturer information are considered “(1) the manufacturer’s suggest retail price of said model to calculate the average value, (2) the manufacturer’s base manufacturing costs to calculate the aforementioned average value, and (3) some value as of the date of commercial release to calculate the average”.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marissa Thein whose telephone number is 571-272-6764. The examiner can normally be reached on M-F 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mtot
July 23, 2006


F. RYAN ZEENDER
PRIMARY EXAMINER